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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,410	04/01/2004	Larry A. Gilbertson	38-15(51091)B	9581
46795	7590	08/07/2007	EXAMINER	
FULBRIGHT & JAWORSKI, L.L.P.			FOX, DAVID T	
600 CONGRESS AVENUE, SUITE 2400			ART UNIT	PAPER NUMBER
AUSTIN, TX 78701			1638	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10816410	4/1/2004	GILBERTSON, LARRY A.	38-15(51091)B

EXAMINER

David T. Fox

ART UNIT

PAPER

1638 20070803

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

David T Fox
Primary Examiner
Art Unit: 1638

The reply filed on 18 May 2007 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): The amendment results in the switching of inventions to a non-elected invention, wherein all of the pending claims are now withdrawn as being drawn to non-elected inventions, as stated below. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Newly submitted claims 24-27, and newly amended claims 14, 16-23, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The Restriction Requirement of 26 September 2006 indicated that Group III, corresponding to claims 14-23, drawn to transformed plants *not comprising ancillary DNA*, was patentably distinct from the remaining claims which recited *methods for transforming cells with ancillary DNA comprising a negative selection marker* (see, e.g., original claims 1 and 4-5). Group III, corresponding to transgenic plants which lack ancillary DNA, was elected without traverse by Applicant on 25 October 2006.

However, the amendment of 18 May 2007 amended claim 14 to recite transgenic plants containing a negative selectable marker gene, wherein said negative selectable marker gene was defined as a type of ancillary DNA in original claims 4-5. Amended claims 16-23 recite transgenic seed and progeny which also comprise the negative

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selectable marker gene. New claims 24-25 are drawn to plant cells which comprise the negative selectable marker gene. New claims 26-27 are drawn to methods for transforming plant cells with a negative selectable marker gene, corresponding to original claims 10 and 13.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14 and 16-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

It is noted that the Examiner objected to claim 14 as depending upon a non-elected claim, on page 2 of the Office action of 18 January 2007. However, the Examiner did not invite Applicant to amend claim 14 to incorporate non-elected subject matter, namely a transformed plant comprising ancillary DNA. Instead, the Examiner assumed that Applicant would amend claim 14 to retain the product-by-process format of the claim, but to actively recite all of the process steps in the amended independent claim, as stated below.

Original claim 14 is drawn to a transformed plant produced by a method comprising transforming a plant cell with ancillary DNA flanked by repeating sequences, followed by a step of generating progeny cells or plants, wherein progeny cells or plants lack the ancillary DNA due to the deletion of repeating sequences. The Examiner expected Applicant to amend claim 14 to recite all of the above subject matter in a single independent claim, including the final method step where the deletion of the

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ancillary DNA occurred. The Examiner did not expect Applicant to amend claim 14 to recite a transformed plant before the progeny were produced, i.e. before the ancillary DNA had been deleted. The confusion is regretted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 3, 2007

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1638

